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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,597	05/15/2001	Wai C. Wong	45704-GA/JPW/BJA	9652
7590	03/22/2004		EXAMINER COLEMAN, BRENDA LIBBY	
John P. White Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			ART UNIT 1624	PAPER NUMBER

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/855,597	Applicant(s) WONG ET AL.	
	Examiner Brenda L. Coleman	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16,20-23,25,27-31,41,42,45,59-61,66 and 67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16,20-23,25,27-31,41,42,45,59-61,66 and 67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 14-16, 20-23, 25, 27-31, 41, 42, 45, 59-61, 66 and 67 are pending in the application.

This action is in response to applicant's amendment filed December 15, 2003.

Claims 62-65 were canceled and claims 59, 66 and 67 were amended.

Response to Amendment

Applicant's arguments filed December 15, 2003 have been fully considered with the following effect:

1. The applicants amendments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection labeled paragraph 2 in the last office action, which is hereby **withdrawn**.

2. With regards to the obviousness-type double patenting rejection of claims 14-16, 20-23, 25, 27-31, 41, 42, 45 and 59-67 maintained in the last office action, the applicant's arguments have been fully considered but are not found persuasive. The applicants stated that withdrawal of this provisional rejection is proper in accordance with MPEP Section 822.01. If this were the only issue remaining this would be proper however, in view of the rejections maintained and made below the provisional obviousness-type double patenting rejection is once again maintained.

Claims 14-16, 20-23, 25, 27-31, 41, 42, 45, 59-61, 66 and 67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 09/730,458. Although the conflicting claims are not identical, they are not patentably distinct from each other

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because the compounds, compositions and method of use of the instant invention are embraced by the compounds, compositions and method of use of copending Application No. 09/730,458.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. With regards to the 35 U.S.C. § 112, first paragraph rejection of claims 66 and 67 labeled paragraph 6 in the last office action, the applicant's arguments have been fully considered but are not found persuasive. The applicants stated that they "have corrected the structures of previous claims 66 and 67 to match their descriptions on page 82, line 29 through page 83, line 17, and page 112, line 21 through page 114, line 8, respectively". While it is acknowledged that page 82, line 29 through page 83, line 17, i.e. example 8 supports claim 66, page 112, line 21 through page 114, line 8, i.e. example 17 does not support claim 67. The structure in claim 67 includes the amide, but example 17 does not.

Claim 67 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for reasons of record and stated above.

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4. The applicants amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejection labeled paragraph 7 in the last office action, which are hereby **withdrawn**.

5. The applicants amendments are sufficient to overcome the 35 U.S.C. § 102, anticipation rejection labeled paragraph 8 in the last office action, which is hereby **withdrawn**.

6. With regards to the 35 U.S.C. § 103, obviousness rejection of claims 14-16, 20-23, 25, 27-31, 41, 42, 45, 59-61, 66 and 67 by Nagarathnam et al., U.S. Patent No. 5,942,517 of the last office action, the applicants stated that R^3 has been limited to one variable in the instant application, as opposed to the 9 variables described for R^3 in U.S. Patent No. 5,942,517. The closest species of the prior art being examples 1-4 and examples 11, 18, 19, 23, etc. differ only in the nature of the A, B, R_1 , R_2 and R_3 substituents. The compounds of the instant invention where R_3 has been limited to a single variable is exemplified in the preferred embodiment of the prior art reference, i.e. page column 5 and column 7, thus the compounds of U.S. Patent No. 5,942,517 where R_3 is the variable as claimed herein were contemplated. Thus contrary to what applicants urge, the interchangeability of such groups is clearly shown by the prior art. Furthermore, applicants are respectfully requested to note that all disclosures of a prior art reference must be considered in determining obviousness. See *In re Lamberti*, 192 USPQ 278; *In re Mills*, 176 USPQ 196; *In re Burkel*, 201 USPQ 67. Therefore, while the species of U.S. 5,942,517 do not directly read on the instant claims, there is no

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obligation on patentee to prepare each and every variant disclosed and claimed because this would impose an undue burden. Thus, the instant R₃ substituted pyrimidine derivative being taught as equivalent to those disclosed in U.S. 5,942,517 have been placed in possession of the public.

Claims 14-16, 20-23, 25, 27-31, 41, 42, 45, 59-61, 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagarathnam et al., U.S. Patent No. 5,942,517, for reasons of record and stated above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00 Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda Coleman
Primary Examiner Art Unit 1624
March 17, 2004